## REMARKS

### A. The Status of the Claims and the Amendments

Claims 33-42 and 56-58 are currently under consideration. Claims 33 and 40 have been amended. Claims 39, 40, and 42 have been found to contain allowable subject matter. Claims 1-32, 43-55, and 59-62 have been previously canceled without prejudice. New claims 63-65 have been added. The claims amendments merely clarify the language of the claims to claim the invention with greater precision and particularity, by harmonizing the language of the claims with the specification. The subject matter recited in the new claims 63-65 has been also disclosed in the originally filed specification.

In particular, the limitation that is added to claim 33 by the proposed amendment is disclosed on of the originally filed specification. The limitation that is added to claim by the proposed amendment is disclosed in FIG. 1 and on page 4, lines 101-116 of the originally filed specification.

Accordingly, it is submitted that neither the claims amendments nor new claims 63-65 introduce any new matter.

### B. Rejection under 35 U.S.C. § 102(b)

Claims 33-35 have been rejected as allegedly being anticipated by U.S. Patent No. 5,985,214 to Stylli et al. This rejection is respectfully traversed.

It is axiomatic, that to establish anticipation by a reference under 35 U.S.C. § 102(b), the reference must disclose each and every element of the claims at issue. Stylli et al. fail to disclose an optical assembly that is capable "to detect a light signal while the reagent is being dispensed into the sample, " as recited by claim 33, as amended. Since this limitation is not

disclosed by Stylli et al., it is respectfully submitted that Stylli et al. do not disclose each and every element of claim 33.

In addition, it is submitted that Stylli et al. has the publication date 11/16/99 and the filing date 05/16/97. The present publication has the effective priority date 07/17/98, as a divisional application of USSN 09/118,728, now U.S. Patent No. 6,608,721. Therefore, Stylli et al. was published after the effective priority date of the present application. Therefore, Stylli et al. does not qualify as a 35 U.S.C. § 102(b) reference, but may only qualify as a 35 U.S.C. § 102(e) reference.

In view of the foregoing, claim 33 is considered patentably distinguishable over Stylli et al. Each of claims 34 and 35 depends on claim 33 and is patentable for at least the same reason. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**C. Rejection under 35 U.S.C. § 103(a)**

Claims 36, 37, and 41 have been rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over Stylli et al. in view of U.S. Patent No. 5,037,199 to Hlousek et al. Furthermore, claim 38 has been rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over Stylli et al. in view of Hlousek et al. and further in view of U.S. Patent No. 5,926,592 to Harris et al. Furthermore, claims 56-58 have been rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over Stylli et al. in view of Harris et al. These rejections are respectfully traversed.

The subject matter of Stylli et al. and the subject matter of the invention claimed in the present application were commonly owned by Vertex Pharmaceuticals LLC of San Diego, California, at the time the claimed invention was made, and are now commonly owned by Aurora Discovery, Inc. of San Diego, California. The commonality of ownership can be seen from the fact that both Stylli et al. and the parent patent of the present application (U.S. Patent 6,608,671)

were assigned by Vertex Pharmaceuticals LLC to Aurora Discovery, Inc. The recordation of assignment was made on December 16, 2003 (Reel 014196, Frame 0860).

As demonstrated above, Stylli et al. can only potentially qualify as a prior art reference under 35 U.S.C. § 102 (e) but does not qualify as a 35 U.S.C. § 102 (b) reference. Accordingly, under 35 U.S.C. § 103(c), Stylli et al. may not be used as a reference against the present application for purposes of a rejection under §103(a), as per MPEP § 706.02(l).

Since every combination of art used by the Examiner to formulate the obviousness rejection requires using Stylli et al., it is submitted that the §103(a) rejection is improperly taken and should be withdrawn.

**D. Double Patenting Rejection**

Claims 33-42 and 56-58 have been rejected under the non-statutory, judicially created doctrine of obviousness-type double patenting over claims 1-13 of U.S. Patent No. 6,349,160. While the Applicants respectfully traverse this rejection, it is believed that this issue has become moot in view of the terminal disclaimer which accompanies this response. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

## CONCLUSION

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved, the Examiner is requested to contact the undersigned at the telephone number given below so that a prompt disposition of this application can be achieved.

Enclosed is Check No. 577609 in the amount of $130.00 for the Terminal Disclaimer fee. The Commissioner is hereby authorized to charge for any other fees that may be associated with this communication, or credit any overpayment to Deposit Account No. 07-1896.

Respectfully submitted,

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